

Atty's Docket: Bayer 10, 203

Examiner has Conceded that the Inventions in Claim 14 Could be Examined Together

In the original claims as filed, claim 1 was drawn to human telomerase, and "its functional equivalents, its variants, and its catalytically active fragments." This claim is substantially more broad than pending claim 14.

*This is not an argument
to broad to perform a search
indicative*

*6 DNA
and 6 prot*

In the first Restriction Requirement issued on May 22, 2001, Examiner grouped all of claim 1's variants together. This group included claim 1 drawn to catalytically active telomerase, functional equivalents and fragments thereof. In essence, Examiner has already gone on the record that human telomerase and its variants (1) possess unity of invention, and (2) would not provide an overly burdensome search.

Further, on page 4 of the Office Action of August 15, 2001, Examiner indicates that the "hTC protein variants named Variant 1-4 in Example 11" satisfied the enablement requirement. This included the DNA encoding these variants. Therefore, in the previous restriction requirement, Examiner had already acknowledged these sequences should be examined together.

*The fact
that Variants
1-4 are
enabled
does not
mean that
they should
be examined
together*

Thus, these variants were already deemed to have unity of invention and were properly searched. There is no reasonable explanation as to why they should not be examined together as well. They should not be treated differently at this stage of the prosecution and be subjected to restriction.

Applicants respectfully suggest that to now restrict the variants appears arbitrary and unfair to the Applicants.

Accordingly, Applicants request that the restriction between GROUPS V-VIII be withdrawn and that newly amended claim 14 be examined.

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Rule 1.475 Does not Require Restriction

In the restriction requirement, Examiner states that "*37 CFR 1.475 does not provide for multiple products or methods within a single application, therefore unity of invention is lacking with regards to Group V-VIII.*" Applicants respectfully point out that this is not a correct interpretation of this rule for the reasons set forth below.

Apparently, Examiner relies on 37 CFR Rule 1.475(d) that states:

d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see **PCT Article 17(3)(a)** and **§ 1.476(c)**.

Examiner is reading this rule out of its proper context. Rule 1.475(d) refers back to 1.475 (b)-(c) that address inventions in different categories.

The restriction in this application targets highly related nucleic acids having identical utilities. Thus, the claims presented do not even remotely constitute the situations contemplated in Rule 1.475 (b)-(d).

Instead, the Markush group presented in amended claim 14 should be addressed under *Rule 1.475(a)*, wherein the unity of invention inquiry is limited solely to determining the presence of a special technical feature possessed by each variant in the claim.

Thus, it is clear that 37 CFR § 1.475 in no way represents a *per se* bar to multiple products. If it did present such a bar the rule would be in direct contradiction with other PCT rules relating to Markush practice wherein the propriety of claiming multiple embodiments, i.e., multiple products, is beyond reasonable dispute.

On this basis alone, the Applicants respectfully suggest that the restriction should be withdrawn.

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PCT Rules Clearly Support that Markush Group in Claim 14 Possess a Common Special Technical Feature

Claim 14 provides a Markush group of variants and functional equivalents of the sequence according to SEQ ID NO: 1. Further, each variant possesses the same utility.

Because of the identity of utility and high level of structural and functional similarity, Applicants respectfully suggest that these variants indeed share special technical features. Therefore, as explained and exemplified under *PCT Administrative Instructions - Annex B*, claim 14 should be examined in its totality in the same application.

Examiner's attention is respectfully directed to page AI-61 of the MPEP. The *PCT Administrative Instructions* clearly allow for Markush groups consisting of multiple chemical products that share a common technical feature, and a common utility. See Examples 18-20.

Applicants respectfully solicit withdrawal of the restriction requirement because claim 14 presents a Markush group that is closely analogous to that in the PCT examples.

Therefore, examination of amended claim 14 above is respectfully requested.

Respectfully Submitted,

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